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09/996,208	11/28/2001	Gregory W. Cox	CML00090N(69611)	1240

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FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LASALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER
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PATEL, JAYANTI K

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GREGORY W. COX  
and  
AARON M. SMITH

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Application No. 09/996,208  
Technology Center 2600

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Mailed: March 4, 2009

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Before PAMELA S. BENNETT, *Review Team Paralegal*.  
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on February 9, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

**APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER**

Appellants filed an Appeal Brief dated November 3, 2005. The Appeal Brief is not in compliance with 37 CFR § 41.37(c) effective September 13, 2004.

According to 37 CFR § 41.37(c) (v) (2005), an Appeal Brief must include the following:

(v) ***Summary Of Claimed Subject Matter.*** A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 2-6 of the Appeal Brief filed November 3, 2005 is deficient because it does not separately map the independent claims (1, 8 and 11) to the specification. Correction is required.

Section 1205.03 of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 3, August 2005) states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR

41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

**EXAMINER'S ANSWER, EVIDENCE RELIED UPON**

MPEP §1207.02 states:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

- (8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and in the case of nonpatent references, the relevant page or pages.

The Examiner's Answer mailed January 12, 2006 is deficient because the "Evidence Relied Upon" section fails to include the Alkhatib et al. and Schutte et al. references cited on page 3 in the Examiner's Answer's grounds of rejection of claims 1-16 under 35 U.S.C. § 103(a), and applicant's admitted prior art cited on page 6 in the Examiner's Answer's grounds of rejection of claims 17 and 18 under 35 U.S.C. § 103(a).

Appropriate correction is required.

**CONCLUSION**

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed November 3, 2005 defective, as required by 37 CFR § 41.37(d);
- 2) to notify the Appellants to submit a “paper” which corrects the Appeal Brief’s Summary of Claimed Subject Matter under 37 CFR §41.37(c)(1)(v);
- 3) to acknowledge and consider any “paper” submitted by Appellants to correct the Appeal Brief;
- 4) to issue a PTOL-90 citing the missing references listed under the “Evidence Relied Upon” section, paragraph (8); and
- 5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

Fitch Even Tabin and Flannery  
120 South LaSalle Street  
Suite 1600  
Chicago, IL 60603-3406